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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/714,523

11/14/2003

Gilles Houle

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EXAMINER

LU, TOM Y

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

01/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/714,523	<b>Applicant(s)</b> HOULE ET AL.	
	<b>Examiner</b> Tom Y. Lu	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1093-1110, 1113-1116, 1119, 1120, 1123-1130, 1133, 1134, 1136 and 1138-1157 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/24/2008</u>  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Disposition of Claims: Claims pending in the application are 1093-1110,1113-1116,1119,1120,1123-1130,1133,1134,1136 and 1138-1157.

## **DETAILED ACTION**

### ***Allowable Subject Matter***

1. Applicant is advised that the Notice of Allowance mailed 08/22/2008 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

2. The indicated allowability of claims 1093-1110, 1113-1116, 1119-1120, 1123-1130, 1133-1134, 1136, 1138-1157 is withdrawn in view of the newly discovered reference(s) to Page (U.S.P.N. 6,464,134 B1). Rejections based on the newly cited reference(s) follow.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 11/24/2008 has been considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1093-1110, 1113-1116, 1119-1120, 1123-1130, 1133-1134, 1136, 1138-1157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Page (U.S. Patent No. 6,464,134 B1).

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- a. As per claim 1093, Page teaches at issuing terminal 10 scanning pre-printed account data found on the face of a bank check and combine such pre-printed account data with a individualized payee data to create a first set of data; Pages also teaches scanning a redemption check at a cashing terminal 14 to create a second set of data, which includes the pre-printed account data and individualized payee data on the check, and comparing the first set of data and second set of data on a processing center 12 to determine validity of the check (column 6, lines 46-67; column 7, lines 1-42 and column 8, lines 15-40). In Page's example, the checks at the terminal 10 and 14 are the same check, which is different from the claimed "one other payment instrument". Nonetheless, Page teaches the creation of first set of data is an integration of scanned pre-printed account data and manually inputted individualized payee data. At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to recognize in the event that a multiple number of checks from a single person/account are to be issued, it would have been advantageous to modify the system to require only scanning of one check for pre-printed data and manually inputting the payee data for different checks, and in doing so, it would eliminate the redundant scanning process for all the checks and it allows the pre-printed account data on the first check to be used for the subsequent checks. Consequently, it would satisfies the claimed "one other payment instrument"
- b. As per claim 1094, Page discloses the payment instrument is a check.
- c. As per claim 1095, the examiner notes Giro is also a check.

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- d. As per claim 1096, see column 6, lines 55-59.
- e. As per claim 1097, see column 6, line 67 and column 7, line 1.
- f. As per claim 1098, see column 6, line 67 and column 7, line 1.
- g. As per claim 1099, see column 6, line 67 and column 7, line 1.
- h. As per claim 1100, Page teaches the first set of data comprises pre-printed account data.
- i. As per claim 1101, see column 6, line 67 and column 7, line 1.
- j. As per claim 1102, the check at terminal 10 is validated payment instrument.
- k. As per claim 1103, Page teaches the first set of data includes signature data.
- l. As per claim 1104, column 7, lines 18-19.
- m. As per claim 1105, column 7, lines 18-19.
- n. As per claim 1106, see explanation in claim 1103.
- o. As per claim 1107, see explanation in claim 1103.
- p. As per claim 1108, Page's system includes a CPU, a data memory and a system memory, see figure 1, and the rest see explanation in claim 1093.
- q. As per claim 1109, Page's system is a computer system, which inherently contains a compute readable medium, and the rest see explanation in claim 1093.
- r. For claims 110, 1113-1116, 1119-1120, 1123-1130, 1133-1134, 1136, 1138-1150, see explanations above.
- s. As per claim 1151, Page at column 11, lines 2-11, teaches when there is discrepancy between the first set of data and the second set of data, it depends on the terms of account data and individualized data, the personnel at the cashing

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terminal 14 may take appropriate actions, which means if some field, such as the signature, is shown to be false, the cashing terminal would not be able to verify it over the phone with the payor, but if there is a difference of amount to be paid, it can be solved with a phone call to the payor. It implies it weighs certain fields of data more than the others.

- t. As per claim 1152, see explanation in claim 1152.
- u. As per claim 1153, Pages teaches the content of the first set of data must be identical to the content of the second set of data, which includes cross-relationship between the individualized data of check value with the pre-printed account data of payor's account number must be the same with the second set of data.

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teaching for the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potential teaching all or part of the claimed invention, as well as the context of the a passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Y. Lu whose telephone number is (571)272-7393. The examiner can normally be reached on 8:30AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Werner can be reached on (571)-272-7401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tom Y Lu/

Primary Examiner, Art Unit 2624